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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,959	02/12/2002	Avery J. Evans	SPEC-6150	6989
7590	11/19/2004		EXAMINER	
Allegiance Corporation Attn: Kim Diliberti 1430 Waukegan Road McGaw Park, IL 60085-6787			BONDERER, DAVID A	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/074,959	EVANS ET AL.
Examiner	Art Unit	
D. Austin Bonderer	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 03 November 2004.
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1-28 is/are pending in the application.
  - 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-27 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-19-02
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Claim 28 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11-3-04.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Box et al. in view of Miller et al.

Box discloses a syringe assembly comprising:

- A plunger with a threaded section and a non-threaded section 59, 60 and a handle that acts like a stop;
- A dispenser hub assembly with a threaded section 13;
- A hollow tube for containing fluid 11;
- The fluid is pushed via rational movement;
- Shaft has a groove containing the O-ring 56;
- A release assembly with a spring bias a trigger and an actuator Fig. 5;
- The trigger having a threaded portion 41;

Art Unit: 3732

- The tube is "adapted to" receive t tubing assembly for facilitating the delivery of fluid;
- The tube can separated and disposed; and
- Tubing removable attached to the tube.

Box lacks the use of a handle and funnel shaped transparent tube with indicia. Miller teaches all of these elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide box with the elements of Miller for the following reasons:

- A handle to better 'handle' the apparatus;
- A Funneled shape to allow for easy insertion in the threaded elements while allowing for small volume of fluid flow or the application of higher driving presser; and
- Indicia to allow for the determination of how much fluid had flown.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 1964 (1987). The use during the application of cement is considered to be intended use. The structure presented meets the limitations of the claims. In any case Miller discloses the use of PMMA; therefore, teaches the use of bone cement.

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Also, all kit claims require to meet the limitations is that the individual items are shown to be known. The placing of such items into a bag/kit does not rise to the level of invention.

4. Claim 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Box/Miller as applied to claim 22 in view of Kokernak.

Box/Miller do not specifically state what kind of connection they have. However it is well known in the medical art that syringes can employ the Luer fitting. In any case Kokernak teaches the use of a Luer fitting. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide to provide Box/Miller with the Luer fitting, as they are compatible with many surgical tubings.

5. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Box/Miller as applied to claim in view of Murphy.

Murphy discloses a hammer, a cannula, and a stylet. It would have been obvious to one of ordinary skill in the art at the time of the invention to put all the items in a kit.

6. Claim 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Box/Miller/Murphy as applied to claim 25 in view of Jacklich.

Jacklich discloses forceps. It would have been obvious to one of ordinary skill in the art at the time of the invention to put all the items in a kit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Austin Bonderer whose telephone number is 571.272.4708. The examiner can normally be reached on Monday- Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571.272.4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dab

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PRIMARY EXAMINER